

Office Action Summary

Application No.

10/791,552

Applicant(s)

DICARLO ET AL.

Examiner

ALTON N. PRYOR

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-50,52-57 and 59-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-42,50,55,56,59-71,73-77 and 100 is/are allowed.
- 6) ☒ Claim(s) 43-47,49,50,52,57,72 and 78-99 is/are rejected.
- 7) ☒ Claim(s) 48,53,54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/21/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments, see papers, filed 3/25/09 and 6/15/09, with respect to the rejection(s) of claim(s) under 103(a) and ODP have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below. Previous rejections not addressed below are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 43*,44*,45,46*,47*,49*,50*,52*,57*,72*,78*,79,80*-85*,86-92,93*,94,95*-97*,98 and 99* are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially devoid" in claim 43 is a relative term which renders the claim indefinite. The term "substantially devoid" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification does not set forth what is meant by the term "substantially devoid".

The term "substantially linear" in claim 57 is a relative term which renders the claim indefinite. The term "substantially linear" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one

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of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification does not set forth what is meant by the term "substantially linear".

The term "substantially spherical" in claims 72 and 96 is a relative term which renders the claim indefinite. The term "substantially spherical" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification does not set forth what is meant by the term "substantially spherical".

The term "at most about" in claims 44,49,52,78 is a relative term which renders the claim indefinite. The term "at most about 50" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term appears to because the term can mean about 50 or at most 50. The about 50 would be interpreted as being slightly above and slightly above 50, whereas at most 50 would be interpreted as being from zero to no more than 50.

** - the actual claims where the problem/concern is recited.*

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The term "at least about" in claims 46,47,50,80,81 is a relative term which renders the claim indefinite. The term "at most about 0.1" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term appears to because the term can mean about 0.1 or at least 0.1. The about .01 would be interpreted as being slightly above and slightly above 0.1, whereas at least 0.1 would be interpreted as being 0.1 and above 0.1.

Claims 78,80-85,93,95-97,99 are rejected for defining both the interior region and surface region as being the distance from the radius (r) of the particle to about $2r/3$. In claims 78,80-85,93,95-97,99 the interior region extends from the radius (r) of the particle to about $2r/3$ and the surface region extends from the radius of about $2r/3$ to r . It appears that the interior region and the surface region are defined as the same. Please clarify.

Duplicate Claim, Warning

Applicant is advised that should claim 37 be found allowable, claims 53 and 54 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Note claim 37 comprises a halogenated/fluorinated polymer as recited in claims 53 and 54.

Other Matter

In claim 37,78,80-85,93,95-97,99 line 3 after "wherein" insert --- the ---.

Claim 48 is depending from itself. Please correct.

In claims 78,80-85,93,95-97 and 99 line 9 after "than" insert --- in ---.

Allowable Subject Matter

Claims 37-42,50,55,56,59-71,73-77 and 100 are allowable. The prior art does not teach or suggest the instant invention comprising a polymer having the group D-B-[O-(A-O)n-B]-D attached.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616